IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

JAMES D. MARKS, MARIE ALIX POUL, and BALTAZAR BECERRIL

Application No.: 09/249,529

Filed: FEBRUARY 12, 1999

For: METHODS OF SELECTING FOR INTERNALIZING ANTIBODIES

Examiner: P. PONNALURI

Art Unit: 1627

Assistant Commissioner of Patents
Washington, D.C. 20231

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner of Patents, Washington, D.C. 20231 on May 3, 2000.

Julie M. Balot — Date 5/3/2000

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

In response to the Office Action dated February 3, 2000, Applicants respectfully request reconsideration of the above-identified application in view of the following remarks. A petition to extend the period of response for one month is enclosed.

In the February 3, 2000 Office Action the Examiner required restriction to one of the following groups under 35 U.S.C. §121:

Group I: Claims 1-17, drawn to method s of selecting internalizing antibodies or polypeptides;

Group II: Claims 18-29, drawn to a method of identifying an internalizing receptor;

Group III: Claims 30-41, and 48-50,drawn to a multivalent antibody phage display library and a kit comprising a polyvalent phage display antibody library.; recurrence of cancer; and

Group IV: Claims 42-47, drawn to a nucleic acid library encoding an antibody library.

In response to this restriction requirement, Applicants provisionally elect Group I, claims 1-17, with traverse.

Applicants submit that restriction between Groups I and II is unnecessary. According to MPEP §803, the Examiner should examine all claims in an application, **even though they are directed to distinct inventions**, unless to do so would create a **serious burden**. Group I claims are directed to methods of identifying internalizing antibodies. The claims of Group II are directed to the use of such internalizing antibodies to detect/identify internalizing receptors. The methods of Group II embody the steps of the methods of Group I. A search for methods of Group I is expected to identify prior art, if it exists, relevant to the methods of Group II. Thus, a search for art relevant to Groups I and II together entails no greater burden than a search for art relevant to Group I alone. Accordingly, Examination of Groups I and II together entails no serious burden and the restriction between these groups should be withdrawn.

Similarly Group III is drawn to a multivalent antibody phage display library and Group IV is drawn to nucleic acids encoding such a library. Again, a for such a multivalent phage display library is expected to identify prior art, if it exists, relevant to nucleic acids encoding such a library. A search for art relevant to Groups III and IV together entails no greater burden than a search for art relevant to Group III alone. Examination of Groups III and IV together entails no serious burden and the restriction between these groups should be withdrawn.

Applicants therefore respectfully request that the above identified restriction requirements be withdrawn.

In view of the foregoing, Applicant believes all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (415) 248-5500.

Dated: May 3, 2000.

Respectfully submitted,

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Atty. Docket: 2500.116US1

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